

REMARKS

This Response is submitted in reply to the Office Action dated September 26, 2007. Claims 1, 5, 9, 15, 21, 25, 29, 31 to 38, 42 to 45, 48 to 50, 63 and 67 have been amended. Claims 30 and 41 have been cancelled without prejudice or disclaimer. No new matter has been added by these amendments.

A Petition for a One-Month Extension of Time for filing this Response, Terminal Disclaimers, a new Declaration and a Petition to Change Inventor's Name are submitted herewith. Please charge deposit account 02-1818 for any fees which due in connection with this Extension of Time, these Terminal Disclaimers, the corrected Declaration, the Petition and this Response.

The Office Action objected to the filed Declaration as defective. Applicant has corrected the previously filed Declaration and submits a new Declaration.

The Office Action rejected Claims 1 to 70 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 37 of U.S. Patent No. 6,808,454. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 1 to 70 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 31 of U.S. Patent No. 6,494,785. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 1 to 70 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 46 of U.S. Patent No. 6,786,820. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections. The Office Action rejected Claims 1 to 70 on the ground of nonstatutory obviousness-type double patenting as being unpatentable

over Claims 1 to 26 of U.S. Patent No. 6,971,953. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 30 and 41 under 35 U.S.C. §101 because the disclosed invention is inoperative and therefore lacks utility. Applicant has cancelled Claims 30 and 41 without prejudice or disclaimer.

The Office Action rejected Claims 29 to 50 under 35 U.S.C. §112, second paragraph as being indefinite. The Office Action stated that these claims recite two separate pluralities of locations which are not distinguishable from one another. Applicant respectfully disagrees and submits that these Claims (as submitted on September 10, 2003) distinctly claim the subject matter which Applicant regards as the invention. Nonetheless, Applicant has amended certain of these claims to clarify that of the plurality of plurality of locations, a plurality of designated locations form a path between the first location and the second location. Accordingly, such rejections are overcome.

The Office Action rejected Claims 1 to 52, 55, 56, 59, 60, 63, 64, 67 and 68 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,767,283 to Weiss.

Weiss discloses a gaming device having a primary display and a plurality of symbols on the primary display which leads to a first bonus. The first bonus is a serpentine path over which a character must traverse in order to achieve a second bonus. Specifically, a first bonus event involves a playing path that a simulated character is required to traverse. The number of steps that the simulated character takes is determined by a spinner located in a video screen which the player activates. In this first bonus event, a certain number of spins are allocated the player. Each time the character lands on a spot on the path which correlates to a credit value, that credit value is posted to the player's account. In addition, along the playing path are spaces which, if the character advances and stops thereat, signals the end of the bonus event. These spaces which indicate the end of the bonus event are entitled "Go Home". Should the player advance the character to the terminus of the playing path, a second bonus round evolves.

Applicant respectfully submits that Weiss does not disclose a processor operable to (a) cause the symbol to move to at least one location along the path toward the first location, (b) relocate the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, and (c) repeat (a) to (b) until the symbol moves to the first location. In Weiss, if a setback condition occurs (i.e., the character stopping on a "Go Home" spot), the bonus game ends and the character does not move to any additional spots. On the other hand, in the gaming device of amended independent Claim 1, the processor is operable to (a) cause the symbol to move to at least one location along the path toward the first location, (b) relocate the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, and (c) repeat (a) to (b) until the symbol moves to the first location. In other words, in the gaming device of amended independent Claim 1, after the symbol is relocated to one of the path locations further from the first location (in response to the symbol moving to a location associated with the setback condition), the symbol is moved to at least one location toward the first location. For at least this reason, amended independent Claim 1 is patentably distinguished over Weiss and in condition for allowance.

As the gaming devices/methods of operating a gaming device of independent Claims 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 and 67 each generally include, amongst other elements, moving the symbol to at least one location along the path toward the first location after the symbol is relocated further from the first location, Applicant respectfully submits that for similar reasons to those described above with respect to amended independent Claim 1, the gaming devices/methods of operating a gaming device of independent Claims 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 and 67 are also patentably distinguished over Weiss and are in condition for allowance.

Claims 2 to 4, 6 to 8, 10 to 14, 16 to 20, 22 to 24, 26 to 28, 30 to 33, 35 to 37, 39 to 44, 46 to 50, 52, 56, 60, 64 and 68 depend directly from amended independent Claims 1, 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 and 67 are also allowable for the reasons given with respect to Claims 1, 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 and 67 and because of the additional features recited in these claims.

The Office Action rejected Claims 53, 54, 57, 58, 61, 62, 65, 66, 69 and 70 under 35 U.S.C. §103(a) as being unpatentable over Weiss in view of Official Notice.

In the Office Action, the Examiner took Official Notice that it was notoriously known to those of ordinary skill in the art to operate gaming machines through a data network including the internet in order to control gaming devices from a remote location. The Office Action concluded that such claims are obvious in view of the teachings of the prior art.

Applicant respectfully submit that regardless of whether or not it would have been obvious to operate the gaming device of Weiss through a data network, unlike the methods of operating a gaming device of dependent Claims 53, 54, 57, 58, 61, 62, 65, 66, 69 and 70, Weiss does not disclose moving the symbol to at least one location along the path toward the first location after the symbol is relocated further from the first location in response to a setback condition. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Weiss in view of Official Notice to result in such a gaming device/method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. Accordingly, Applicant respectfully submits that for similar reasons to those described above with respect to amended independent Claim 1, the methods of operating a gaming device of dependent Claims 53, 54, 57, 58, 61, 62, 65, 66, 69 and 70 are also patentably distinguished over Weiss in view of Official Notice and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Adam H. Masia

Reg. No. 35,602

Customer No. 29159

Dated: January 15, 2008